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V.S.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/163,778	09/30/98	LEPINE A	IAM498PA

IM22/1228
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EXAMINER	
DUBOIS,P	
ART UNIT	**PAPER NUMBER**
1761	5

DATE MAILED: 12/28/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/163,778	Lepine
Examiner	**Group Art Unit**
Philip DuBois	1761

☒ Responsive to communication(s) filed on *Sep 30, 1999*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-14* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-14* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

NON-FINAL OFFICE ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3-5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oftedal (Lactation in the Dog: Milk Composition and Intake by Puppies, pg. 807) in view of Kakade (U.S. Patent 4,614,653).

The references of Oftedal and Kakade are being applied for the reasons stated in the first Office Action. Oftedal teaches the fat, protein and carbohydrate levels of an animal milk. However, Oftedal is silent as to the specific type of proteins in the milk. However, as noted in the previous Office Action, Kakade clearly teaches the use of specific ingredients in an artificial milk. However, it was not noted in the first Office Action that Kakade teaches the addition of casein and whey to the milk product (U.S. Patent 4,614,653, col. 4, lines 25-28). Although Kakade is silent as to the ratio of casein to whey, it would have been obvious to one of ordinary skill in the art to optimize the ratio of the protein mix since the protein ratio is a result effective

variable that effects the digestion and absorption in the gastrointestinal tract of a monogastric animal (U.S. Patent 4,614,653, col. 2, lines 55-60). In fact, Kakade teaches that the character of the protein is important for young monogastric animals to provide the necessary growth factors.

Thus, it would have been obvious to one of ordinary skill in the art

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oftedal in view of Kakade as applied to claims 1, 3-5 and 9 above, and further in view of Irvine et al (U.S. Patent 4,692,338).

Oftedal, Kakade and Irvine et al are being applied for the reasons noted in the first Office Action.

4. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oftedal in view of Kakade as applied to claim 1, 3-5 and 9 above, and further in view of Gil et al (U.S. Patent 5,709,088).

Oftedal, Kakade and Gil are being applied for the reasons noted in the previous Office Action.

5. Claim 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oftedal in view of Kakade and further in view of Gil as applied to claims 6 and 14 above, and further in view of Traitler et al (U.S. Patent 4,938,984).

Oftedal in view of Kakade and further in view of Gil and Traitler are being applied for the reasons noted in the previous Office Action.

6. Claim 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oftedal in view of Kakade as applied to claims 1, 3-5 and 9 above, and further in view of Kinumaki et al (U.S. Patent 4,294,856).

7. Claim 10 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Oftedal in view of Kakade as applied to claim 1, 3-5 and 9 above, and further in view of Fujimori (U.S. Patent 5,294,458).

Oftedal, Kakade and Fujimori are being applied for the reasons noted in the previous Office Action.

In re Levin

Finally, Applicants' attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered on point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

> This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the

particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

U.S. Patent 5,792,501

The Double Patenting rejection in the previous Office Action in view of U.S. Patent 5,792,501 is still maintained for the reasons noted above and the reasons outlined in the Response to Arguments.

U.S. Patent Application 09/362,401

9. Claims 1, 3-5 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent Application No.09/362,401 in view of Oftedal in view of Kakade.

Although the claims are not identical, they are not patentably distinct from each other because the claims of the patent application describe similar limitations of a composition. The difference between the claimed invention of U.S. application number 09/163,778 and claims 1-36 of U.S. Patent Application No.09/362,401 is the intended use. The same composition is being used for use in a canine milk replacer and a feline milk replacer.

The noted references are being used for the same reasons stated above. Thus, it would have been obvious to use the same limitations of a feline milk replacer composition in a canine milk replacer composition, since the composition produces enhanced growth of feline and canine young, as taught by Oftedal in view of Kakade.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent Application No.09/362,401 in view of Oftedal in view of Kakade and further in view of Irvine.

Although the claims are not identical, they are not patentably distinct from each other because the claims of the patent application describe similar limitations of a composition. The difference between the claimed invention of U.S. application number 09/163,778 and claims 1-36 of U.S. Patent Application No.09/362,401 is the intended use. The same composition is being used for use in a canine milk replacer and a feline milk replacer.

Oftedal in view of Kakade and further in view of Irvine are being used for the same reasons stated above. Thus, it would have been obvious to use the same limitations of a feline milk replacer composition in a canine milk replacer composition, since the composition produces enhanced growth of feline and canine young, as taught by Oftedal in view of Kakade and further in view of Irvine.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 6 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent Application No.09/362,401 in view of Oftedal in view of Kakade and further in view of Gil.

Although the claims are not identical, they are not patentably distinct from each other because the claims of the patent application describe similar limitations of a composition. The difference between the claimed invention of U.S. application number 09/163,778 and claims 1-36 of U.S. Patent Application No.09/362,401 is the intended use. The same composition is being used for use in a canine milk replacer and a feline milk replacer.

Oftedal in view of Kakade and further in view of Gil are being used for the same reasons stated above. Thus, it would have been obvious to use the same limitations of a feline milk replacer composition in a canine milk replacer composition, since the composition produces enhanced growth of feline and canine young, as taught by Oftedal in view of Kakade and further in view of Gil.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 7 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent Application No.09/362,401 in view Oftedal in view of Kakade and further in view of Gil and Traitler.

Although the claims are not identical, they are not patentably distinct from each other because the claims of the patent application describe similar limitations of a composition. The difference between the claimed invention of U.S. application number 09/163,778 and claims 1-36 of U.S. Patent Application No.09/362,401 is the intended use. The same composition is being used for use in a canine milk replacer and a feline milk replacer.

Oftedal in view of Kakade and further in view of Gil and Traitler. are being used for the same reasons stated above. Thus, it would have been obvious to use the same limitations of a feline milk replacer composition in a canine milk replacer composition, since the composition produces enhanced growth of feline and canine young, as taught by Oftedal in view of Kakade and further in view of Gil and Traitler.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 8 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent Application No.09/362,401 in view of Oftedal in view of Kakade and further in view of Kinumaki.

Although the claims are not identical, they are not patentably distinct from each other because the claims of the patent application describe similar limitations of a composition. The difference between the claimed invention of U.S. application number 09/163,778 and claims 1-36 of U.S. Patent Application No.09/362,401 is the intended use. The same composition is being used for use in a canine milk replacer and a feline milk replacer.

Oftedal in view of Kakade and further in view of Kinumaki are being used for the same reasons stated above. Thus, it would have been obvious to use the same limitations of a feline milk replacer composition in a canine milk replacer composition, since the composition produces

enhanced growth of feline and canine young, as taught by Oftedal in view of Kakade and further in view of Kinumaki.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 10 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent Application No.09/362,401 in view of Oftedal in view of Kakade and further in view of Fujimori.

Although the claims are not identical, they are not patentably distinct from each other because the claims of the patent application describe similar limitations of a composition. The difference between the claimed invention of U.S. application number 09/163,778 and claims 1-36 of U.S. Patent Application No.09/362,401 is the intended use. The same composition is being used for use in a canine milk replacer and a feline milk replacer.

Oftedal in view of Kakade and further in view of Fujimori are being used for the same reasons stated above. Thus, it would have been obvious to use the same limitations of a feline milk replacer composition in a canine milk replacer composition, since the composition produces enhanced growth of feline and canine young, as taught by Oftedal in view of Kakade.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

U.S. Patent 5,882,714

15. Claims 1, 3-5 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,882,714 in view of Oftedal in view of Kakade.

Although the claims are not identical, they are not patentably distinct from each other because the claims of the patent application describe similar limitations of a composition. The difference between the claimed invention of U.S. application number 09/163,778 and claims 1-24 of U.S. Patent No. 5,882,714 is the intended use. The same composition is being used for use in a canine milk replacer and a feline milk replacer.

The noted references are being used for the same reasons stated above. Thus, it would have been obvious to use the same limitations of a feline milk replacer composition in a canine milk replacer composition, since the composition produces enhanced growth of feline and canine young, as taught by Oftedal in view of Kakade..

16. Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims U.S. Patent No. 5,882,714 in view of Oftedal in view of Kakade and further in view of Irvine.

Although the claims are not identical, they are not patentably distinct from each other because the claims of the patent application describe similar limitations of a composition. The

difference between the claimed invention of U.S. application number 09/163,778 and claims 1-24 of U.S. Patent No. 5,882,714 is the intended use. The same composition is being used for use in a canine milk replacer and a feline milk replacer.

Oftedal in view of Kakade and further in view of Irvine are being used for the same reasons stated above. Thus, it would have been obvious to use the same limitations of a feline milk replacer composition in a canine milk replacer composition, since the composition produces enhanced growth of feline and canine young, as taught by Oftedal in view of Kakade and further in view of Irvine.

17. Claims 6 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,882,714 in view of Oftedal in view of Kakade and further in view of Gil.

Although the claims are not identical, they are not patentably distinct from each other because the claims of the patent application describe similar limitations of a composition. The difference between the claimed invention of U.S. application number 09/163,778 and claims 1-24 of U.S. Patent No. 5,882,714 is the intended use. The same composition is being used for use in a canine milk replacer and a feline milk replacer.

Oftedal in view of Kakade and further in view of Gil are being used for the same reasons stated above. Thus, it would have been obvious to use the same limitations of a feline milk replacer composition in a canine milk replacer composition, since the composition produces

enhanced growth of feline and canine young, as taught by Oftedal in view of Kakade and further in view of Gil.

18. Claims 7 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,882,714 in view Oftedal in view of Kakade and further in view of Gil and Traitler.

Although the claims are not identical, they are not patentably distinct from each other because the claims of the patent application describe similar limitations of a composition. The difference between the claimed invention of U.S. application number 09/163,778 and claims 1-24 of U.S. Patent No. 5,882,714 is the intended use. The same composition is being used for use in a canine milk replacer and a feline milk replacer.

Oftedal in view of Kakade and further in view of Gil and Traitler. are being used for the same reasons stated above. Thus, it would have been obvious to use the same limitations of a feline milk replacer composition in a canine milk replacer composition, since the composition produces enhanced growth of feline and canine young, as taught by Oftedal in view of Kakade and further in view of Gil and Traitler..

19. Claims 8 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,882,714 in view of Oftedal in view of Kakade and further in view of Kinumaki.

Although the claims are not identical, they are not patentably distinct from each other because the claims of the patent application describe similar limitations of a composition. The difference between the claimed invention of U.S. application number 09/163,778 and claims 1-24 of U.S. Patent No. 5,882,714 is the intended use. The same composition is being used for use in a canine milk replacer and a feline milk replacer.

Oftedal in view of Kakade and further in view of Kinumaki are being used for the same reasons stated above. Thus, it would have been obvious to use the same limitations of a feline milk replacer composition in a canine milk replacer composition, since the composition produces enhanced growth of feline and canine young, as taught by Oftedal in view of Kakade and further in view of Kinumaki..

20. Claims 10 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,882,714 in view of Oftedal in view of Kakade and further in view of Fujimori.

Although the claims are not identical, they are not patentably distinct from each other because the claims of the patent application describe similar limitations of a composition. The difference between the claimed invention of U.S. application number 09/163,778 and claims 1-24 of U.S. Patent No. 5,882,714 is the intended use. The same composition is being used for use in a canine milk replacer and a feline milk replacer.

Oftedal in view of Kakade and further in view of Fujimori are being used for the same reasons stated above. Thus, it would have been obvious to use the same limitations of a feline milk replacer composition in a canine milk replacer composition, since the composition produces enhanced growth of feline and canine young, as taught by Oftedal in view of Kakade.

Response to Arguments

21. Applicant's arguments with respect to claim have been considered but are moot in view of the new ground(s) of rejection.

Although the applicant's arguments are moot in view of the new grounds of rejection, the applicant is reminded that generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40 C and 80 C and an acid concentration between 25 and 70% was held to be prima facie obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100 C and an acid concentration of 10%.). See also *In re Hoeschele*, 406 F.2d 1403, 160

USPQ 809 (CCPA 1969) (Claimed elastomeric polyurethanes which fell within the broad scope of the references were held to be unpatentable thereover because, among other reasons, there was no evidence of the criticality of the claimed ranges of molecular weight or molar proportions.). For more recent cases applying this principle, see *Merck & Co. Inc . v. Biocraft Laboratories Inc.* , 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied , 493 U.S. 975 (1989), and *In re Kulling* , 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990)..

In the instant application, the percentage amount of the ingredients are considered result effective variables. Thus, it would have been obvious to one of ordinary skill in the art to optimize the result effective variable. The ingredients of the claimed invention are all known ingredients to one of ordinary skill in the art. Thus, it would have been obvious to one of ordinary skill in the art to optimize a result effective variable for an intended use.

Conclusion

22. No claim is allowed.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip DuBois whose telephone number is (703) 305-0508. The examiner can normally be reached on Monday through Friday from 8:00 to 5:30.The examiner is not in the office the second and fourth Fridays of each month.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lacey, can be reached on (703)-308-3535. The **fax phone number** for this Group is (703)-305-3601.

25. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Philip A. DuBois

December 20, 1999

MILTON CANO
PRIMARY EXAMINER